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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,799	11/02/2001	John Joseph King	LF 102US	3842

7590

08/09/2005

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EXAMINER

DIVECHA, KAMAL B

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,799

Applicant(s)

KING ET AL.

Examiner

KAMAL B. DIVECHA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/18/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20050722</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Claims 1-20 remains cancelled as per applicant preliminary amendment.

Claims 21-49 remains pending in this Office Action.

Applicant has amended the "Related Applications" to provide the current status of the incorporated references. Therefore, Examiner withdraws the objection made to specification.

The newly submitted IDS on July 22, 2005 have been considered by the Examiner.

Applicant's arguments with respect to claims 21-49 have been considered but are moot in view of the new ground(s) of rejection.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 21-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims recite the limitation of "enabling access by said user to said plurality of picture files and said information which has been changed by way of a webpage for a user associated with a wireless service provider for said cellular telephone" (Amended claim 21, 26, 31, 36 and 41). However, the specification merely describes a method and apparatus for

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displaying a picture file on a cellular telephone and displaying the at least one picture file as a screen saver on a display of the cellular telephone (see abstract), hence, the above claimed limitation presents new subject matter situations and was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 21-22, 24-27 and 29-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shin et al (U. S. Patent No. 6,674,439 B1) in view of Michiyoshi (U. S. Patent No. 5,774,108).

As per claim 21, Shin et al discloses: A method of enabling the display of a picture file on a cellular telephone (col. 11 L44-56), said method comprising steps of: receiving said picture

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file at said cellular telephone (fig. 1 item #10, 11 and fig. 6 step #s109; col. 12 L41-42); displaying a plurality of picture files on a display of said cellular telephone (fig. 6 step # s116; col. 12 L60-63); providing a selection option (read as option for selecting an image) associated with said picture file when said picture file is displayed on said cellular telephone (fig. 12 item #s214, s215, s216; fig. 19; col. 12 L45-52; col. 7 L1-5); and enabling access by said user to said plurality of picture files and said information which has been changed by way of a webpage for a user associated with a wireless service provider for said cellular telephone (fig. 12-13, col. 5 L16-33, col. 9 L50-59, col. 10 L48-67, col. 19 L36 to col. 20 L29), however Shin does not disclose the process of enabling a user to change information displayed with said picture file of said plurality of picture files by way of a user interface on said cellular telephone.

Michiyoshi, from the same field of endeavor discloses the process of changing the image data displayed on the display screen through a user interface in response to user interaction with the input device (col. 1 L65 to col. 2 L41). Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Shin in order to enable user to change or update information displayed with picture file by a user interface, in view of Michiyoshi since Michiyoshi discloses the user interface which enables user to change the information displayed with image or picture file.

One of ordinary skilled in the art would have been motivated because it would have enabled user to modify, change or update the image data displayed on the display (Michiyoshi, col. 2 L30-41).

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As per claim 22, Shin discloses the process wherein said step of receiving said picture file at said cellular telephone comprises receiving said picture file by way of a wireless link of a telecommunications network (col. 9 L50-59 and fig. 1 item #20).

As per claim 24, Shin discloses the process of storing said picture file on said cellular telephone (col. 12 L42-44; col. 13 L50-58; fig. 12 step # S220; fig. 6 step # S110).

As per claim 25, Shin discloses the process wherein said step of providing a selection option comprises providing a selection box associated with said picture file which can be selected by a user (fig. 19 and fig. 17; fig. 20 item # S410).

As per claim 30, Shin discloses the process of enabling said user to enlarge (read as displaying a full version of image in a display area) said picture file (fig. 6 step # S111, S112 and fig. 19, and fig. 6 step # S116: user selects an image from fig. 19 by focusing in any one image, the size is compared with the size of display area, and if the size of the image does not exceed effective display area, focused image is displayed or enlarged in the effective display area of the display; col. 3 L1-61; col. 12 L64-67 and col. 14 L26-35).

As per claim 32, Shin et al discloses the process of displaying a picture file on a cellular telephone as a thumbnail (defined as a miniature version of an image) of said picture file (fig. 17: the miniature version of images are displayed and further would have been focused or selected in order to display the full version).

As per claim 33, Shin discloses the process of enlarging said picture file comprises a step of displaying said picture file as a window on a display of said cellular telephone (fig. 5 and fig. 6 item # S116).

As per claim 34, Shin discloses the process of enabling the selection of said picture file (fig. 18, fig. 19, fig. 20 and fig. 17).

As per claim 35, Shin discloses the process of presenting said picture file having a designated selection option according to a user selectable function (fig. 6 item # S116 and fig. 19 and fig. 20 item # S410).

As per claim 42, Shin discloses the process of selecting through a check box (fig. 19).

As per claim 43, Shin discloses the cellular telephone comprising an icon on said display, said icon enabling access to said picture file when said icon is selected (fig. 17 and fig. 19 and fig. 6 item #S116).

As per claim 44, Shin discloses the cellular telephone comprising a plurality of picture files stored in said memory (col. 4 L47-60; col. 15 L3-5).

As per claim 45, Shin discloses the cellular telephone comprising a plurality of selection boxes, each said selection box stored with a picture file of said plurality of picture files (fig. 17 item #1601, 1602 and 1603 and associated pictures).

As per claim 46, Shin discloses the cellular telephone wherein said selection box enables a user to select a function for displaying said picture file (fig. 17 and fig. 19).

As per claim 49, Shin discloses the cellular telephone wherein said picture file comprises a thumbnail (fig. 17).

As per claims 26-27, 29, 31, 36-41 and 47-48, they do not teach or further define over the limitations in claims 21-22 and 24-25. Therefore, claims 26-27, 29, 31, 36-41 and 47-48 are rejected for the same reasons as set forth in claims 21-22 and 24-25.

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3. Claims 23 and 28 are rejected under 35 U.S.C. 103(a) as being obvious over Shin et al (U. S. Patent No. 6,674,439 B1) in view of Michiyoshi (U. S. Patent No. 5,774,108), and further in view of Rudy et al. (U. S. Patent No. 6,360,252 B1).

As per claim 23, Shin in view of Michiyoshi does not explicitly disclose the process of receiving said picture file as an attachment to an email.

Rudy, from the same field of endeavor, explicitly discloses the method wherein client machine (read as mobile telephone, col. 3 L39-42) receives the client version of email with descriptor of attachment (attachments contain images, text, video, multimedia documents, etc, col. 1 L25-28; read as receiving image file as attachment to an email, fig. 1 item #20 and #12 and col. 7 L49-53; col. 1 L64-67 to col. 2 L1-10). Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Rudy as stated above with the information terminal device of Shin in order to receive the picture file as an attachment to an email. One of ordinary skilled in the art would have been motivated because the technique would have used where there is a low bandwidth connection between the server and a users mobile device, where there is a high latency connection or where there is a unreliable or intermittent connection. In addition, the technique would have been advantageous because it would have been used where the client machine or a mobile telephone is not adequate to render most attachments due to storage limitations or due to inadequate output capabilities, such as small display or display with inadequate resolution (Rudy, col. 4 L49-61).

As per claim 28, it does not teach or further define over the limitations in claim 23. Therefore, claim 28 is rejected for the same reasons as set forth in claim 23.

Additional References

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see also PTO-892 dated 02/18/05).

- a. Santoro et al., U. S. Patent No. 6,724,403 B1.
- b. Yoshioka, U. S. Patent No. 6,839,068 B2.
- c. Nagahara et al., U. S. Patent No. 6,687,382 B2.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **KAMAL B. DIVECHA** whose telephone number is 571-272-5863. The examiner can normally be reached on Flex schedule 8 hr days (10.00am-6.30pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



August 1, 2005.



ZARNI MAUNG
SUPERVISORY PATENT EXAMINER